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Attorney Docket No. HOS-69
MAIL STOP AMENDMENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:) Group Art Unit: 1772
IMANARI et al.) Examiner: Patricia Nordmeyer
Serial No. 10/782,941)
Filed: February 23, 2004)
For: **FOAM-MOLDED ARTICLE AND MANUFACTURING METHOD
THEREOF**

TRANSMITTAL LETTER

Commissioner for Patents
Alexandria, Virginia 22313-1450

Sir:


Submitted herewith for filing in the U.S. Patent and Trademark Office is the following:

- (1) Transmittal Letter; and
- (2) Response to Restriction/Election Requirement.

Please charge any additional fees, or credit any overpayment, in connection with this matter to deposit Account No. 19-1980.

Respectfully submitted,

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RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Commissioner for Patents
Alexandria, VA 22314-1450

Sir:

This is in response to the Official Action bearing a mail date of December 12, 2005. The one-month shortened statutory period for response is set to expire on January 12, 2006. Accordingly, this response is timely filed.

In view of the following remarks, Applicants respectfully request the Examiner to withdraw the pending restriction requirement.

**SUMMARY OF RESTRICTION REQUIREMENT
AND SPECIES ELECTION**

The Restriction Requirement states as follows:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-3, drawn to a method for manufacturing a foam-molded article, classified in class 264, subclass 41.

II. Claims 4-14, drawn to a foam-molded article with a foam layer, classified in class 428, subclass 36.5.

PROVISIONAL ELECTION

Applicants provisionally elect with traverse Group I, claims 1-3, drawn to a method for manufacturing a foam-molded article as stated in the Restriction Requirement.

TRAVERSAL

Applicants respectfully traverse the Restriction Requirement into Groups I-II because the claims of the respective Groups do not recite mutually exclusive limitations that separate the alleged species of Group I-II from each other. Moreover, the process and apparatus of Groups I and II, respectively are not distinct from

each other because the process of Group I as claimed cannot be practiced by another materially different apparatus and the apparatus as claimed cannot be used to practice another materially different process.

Applicants note that the proper test for restriction depends on whether or not two or more independent and distinct inventions are claimed within the same application. MPEP § 806. Restriction should never be required where the claims of an application define the same essential characteristics of a single disclosed embodiment of the invention. MPEP § 806.03.

Moreover, for inventions related as process and apparatus, the respective inventions are distinct only if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another materially different process. MPEP § 806.05(e).

Furthermore, claims alleged to be drawn to different inventions must contain mutually exclusive limitations defining those allegedly different species. MPEP § 806.04(f). For example, a proper restriction can only be made between a first claim reciting limitations which under the disclosure are found in a first species but not in a second, and a second claim reciting limitations disclosed only for the second species and not the

first. Id. In other words, claims to be restricted to different species must contain within the language of the claim the mutually exclusive limitations for those species.

In the present application, the limitations of Group I (claims 1-3) drawn to a method of manufacture recite in Group II (claims 4-14) the same exact limitations as those found in Group I. In particular, Group II claims expressly recite the limitation that the foam-molded article of Group II is made by the "manufacturing method according to claim 1". Hence, the foam-molded article with a foam layer recited in Group II (claims 4-14) specifically incorporates the limitations of Group I.

Moreover, the process and apparatus of Groups I and II, respectively, are not distinct from each other because the process of Group I recites a method of manufacturing a foam-molded article with specific limitations with regard to type, process and composition of the foam-molded article. Group II claims reciting the composition directly made from the method of manufacture of Group I must contain those same limitations by virtue of the claim language and therefore cannot be considered by any interpretation to be distinct from the claims of Group I.

Still further, the method of manufacture of Group I cannot be practiced by another materially different apparatus while the apparatus of Group II as claimed cannot be used to practice another

materially different process given that both Groups contain the same exact limitations. It is clear that although Group I claims are drawn to a method of manufacture while Group II claims are drawn to a composition made from that manufacturing method, a close relationship exists between both Groups. In other words, Groups I and II contain common limitations that are not mutually exclusive and therefore cannot be considered to be distinct from each other.

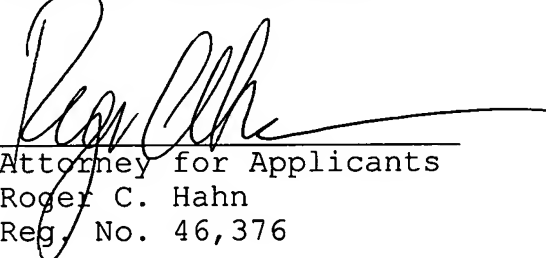
For all these reasons, Applicants respectfully request that the Restriction be withdrawn. In the event the restriction is not overcome, Applicants preserve the right to pursue the subject matter of the unelected claims in later applications as well as petitions and appeals.

CONCLUSION

In view of the foregoing, Applicants respectfully request the Examiner to reconsider and withdraw the restriction requirement and to examine all of the claims pending in this application. If the Examiner has any questions or wishes to discuss this matter, the Examiner is welcomed to telephone the undersigned attorney.

Respectfully submitted,

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